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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.      | CONFIRMATION NO. |
|--|-------------|----------------------|--------------------------|------------------|
| 09/960,320   | 09/24/2001  | James W. Jacobs JR.  | 8177.006.00              | 5341             |
| 30827  | 7590        | 05/24/2005           |                          |                  |
| MCKENNA LONG & ALDRIDGE LLP<br>1900 K STREET, NW<br>WASHINGTON, DC 20006 |             |                      | EXAMINER<br>THAI, CANG G |                  |
|  |             |                      | ART UNIT                 | PAPER NUMBER     |

3629

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/960,320             | JACOBS, JAMES W.    |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Cang G. Thai           | 3629                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-12 and 19-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere idea in the abstract (i.e. abstract ideas, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e. physical sciences as opposed to social sciences for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, use or advance the technological arts.

In the present case, Claim 1 is directed to "a method for providing key performance indicators to a subscriber via a subscription server and subscriber interface, comprising:

presenting a subscriber interface;

identifying in the subscriber interface subscriptions available from a plurality of information sources;

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selecting a subset of the subscriptions in response to input from the subscriber interface;

identifying key performance indicators available from the subset of subscriptions;

selecting key performance indicators from the selected subset of subscriptions in response to input from the subscriber interface; and

providing the selected key performance indicators via the user interface”.

In the present case, Claim 1 does not require any technology. The recited steps of providing information does not apply, involve, use, or advance the technological arts since all of the recited steps can be done with no technology at all. The recited steps only constitute an idea for providing information from a variety of sources through a singer user interface.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful (specific utility), concrete (repeatability and/or implementation without undue experimentation), and tangible (a real or actual affect) result.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is no clear what is the scope of the claimed invention and how the steps are implemented to achieve the scope of the claimed invention? Is it enhancing

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business development approach or maximizing the company market evaluation or launching a business. Applicant is recommended to insert an objective of the claimed invention in the preamble to improve clarity. Providing information is not a proper scope of the claimed invention.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,167,435 (DRUCKENMILLER ET AL).

As for claim 1, DRUCKENMILLER discloses a method for providing key performance indicators to a subscriber via a subscription server and subscriber interface, comprising:

presenting a subscriber interface {Column 2, Lines 2-4, wherein this reads over "potential subscribers access an electronic bulletin board or Internet site"};

identifying in the subscriber interface subscriptions available from a plurality of information sources {Column 2, Lines 4-5, wherein this reads over "voluntarily subscribe to one or more mailing lists by entering their e-mail address"};

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selecting a subset of the subscriptions in response to input from the subscriber interface {Column 2, Lines 5-6, wherein this reads over “selecting one or more subject areas of interest”};

identifying key performance indicators available from the subset of subscriptions {Column 2, Lines 6-8, wherein this reads over “once a subscription request is received, a unique alphanumeric token is generated and associated with the e-mail address”};

selecting key performance indicators from the selected subset of subscriptions in response to input from the subscriber interface {Column 2, Lines 8-9, wherein this reads over “the subscription request is then is added to a list of pending subscriptions”}; and

providing the selected key performance indicators via the user interface {Column 2, Lines 10-12, wherein this reads over “an automated verification message is generated and sent to the entered e-mail address to confirm the subscription”}.

As for claim 2, DRUCKENMILLER discloses the method of claim 1, further comprising:

maintaining a record the selected key performance indicators {Column 2, Lines 12-13, wherein this reads over “the message indicates that a subscription request has been received and contains a unique token”}.

As for claim 3, DRUCKENMILLER discloses the method of claim 2, further comprising:

updating the record of selected metric data if an information source corresponding to the metric data updates the metric data {Column 6, Lines 17-18, wherein this reads over “the subscription address list are updated on a periodic basis”}.

As for claim 4, DRUCKENMILLER discloses the method of claim 1, wherein the key performance indicators are maintained on at least one of the information source separate from the subscription server {Column 6, Lines 20-23, wherein this reads over “the pending subscriptions are evaluated by processing entries in the signup queue 40, where each entry represents a subscription request which not yet been added to the any lists”}

As for claim 5, DRUCKENMILLER discloses the method of claim 4, wherein the subscription server receives key performance indicators from the information sources via a communication media {Column 6, Lines 30-33, wherein this reads over “the contents of the signup queue 40 represents the outstanding subscription requests, i.e., newly received subscription requests and older requests which were not previously confirmed”}.

As for claim 6, DRUCKENMILLER discloses the method of claim 5, wherein the communication media is the Internet {Column 4, Lines 4-6, wherein this reads over “the primary system 12 and subscription solicitation system 18 may be implemented using a conventional computer data server that is connected to the Internet”}.

As for claim 7, which has the same limitations as in claim 1, therefore, it is rejected for the similar reasons set forth in claim 1.

As for claim 8, which has the same limitation as in claim 2, therefore, it is rejected for the similar reasons set forth in claim 2.

As for claim 9, which has the same limitation as in claim 3, therefore, it is rejected for the similar reasons set forth in claim 3.

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As for claim 10, which has the same limitation as in claim 4, therefore, it is rejected for the similar reasons set forth in claim 4.

As for claim 11, which has the same limitation as in claim 5, therefore, it is rejected for the similar reasons set forth in claim 5.

As for claim 12, which has the same limitation as in claim 6, therefore, it is rejected for the similar reasons set forth in claim 6.

As for claim 13, DRUCKENMILLER discloses a system for providing metric information to a subscriber, comprising:

a subscription server for receiving information from a plurality of information sources in a standardized format, the subscription server having a user interface {See Fig. 1, Element 12}; and

at least one communication connection by which the subscription server is capable of being contacted by a user and by which the subscription server is capable of receiving information from a plurality of information sources {See Fig. 1, Element 14},

wherein the user interface allows the user to select a subset of the information sources, the information sources remote from the subscription server and the subscription server receiving metric information from the information sources {See Fig. 1, Element 11}.

As for claim 14, DRUCKENMILLER discloses the system of claim 13, wherein the metric information is a key performance indicator {See Fig. 1, Element 42}.

As for claim 15, DRUCKENMILLER discloses the system of claim 13, wherein the at least one communication connection is made to the subscription server via the



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Internet {Column 4, Lines 4-6, wherein this reads over “the primary system 12 and subscription solicitation system 18 may be implemented using a conventional computer data server that is connected to the Internet”}.

As for claim 16, which has the similar reasons set forth in claim 13, therefore, it is rejected for the similar reasons set forth in claim 13.

As for claim 17, which has the same limitation as in claim 14, therefore, it is rejected for the similar reasons set forth in claim 14.

As for claim 18, which has the same limitation as in claim 15, therefore, it is rejected for the similar reasons set forth in claim 15.

As for claim 19, DRUCKENMILLER discloses a method for providing data to a subscriber via a subscription server and user interface, comprising:

presenting a user interface {Column 2, Lines 2-4, wherein this reads over “potential subscribers access an electronic bulletin board or Internet site”};

identifying in the user subscriber interface data available from a plurality of information sources {Column 2, Lines 4-5, wherein this reads over “voluntarily subscribe to one or more mailing lists by entering their e-mail address”};

selecting a subset of the data in response to input from the user interface {Column 2, Lines 5-6, wherein this reads over “selecting one or more subject areas of interest”};

identifying metric data available from the subset of data {Column 2, Lines 6-8, wherein this reads over “once a subscription request is received, a unique alphanumeric token is generated and associated with the e-mail address”};

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selecting metric data from the selected subset of data in response to input from the user interface {Column 2, Lines 8-9, wherein this reads over “the subscription request is then is added to a list of pending subscriptions”};

receiving the selected metric data {Column 2, Lines 6, wherein this reads over “once a subscription request is received”}; and

providing the selected metric data via the user interface {Column 2, Lines 10-12, wherein this reads over “an automated verification message is generated and sent to the entered e-mail address to confirm the subscription”}.

As for claim 20, which has the similar reasons set forth in claims 4 and 5, respectively, therefore, it is rejected for the similar reasons set forth in claim 4 and 5, respectively.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

I. U.S. Patent:

- 1) U.S. Patent Application Publication No. 2001/0051897 (LOEB ET AL) is cited to teach a method and system for qualifying consumers for trade publication subscriptions,
- 2) U.S. Patent No. 5,999,973 (GLITHO ET AL) is cited to teach use of web technology for subscriber management activities,

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- 3) U.S. Patent No. 6,044,372 (ROTHFUS ET AL) is cited to teach a method and apparatus for publishing information to a communications network and enabling subscriptions to such information, and
- 4) U.S. Patent No. 6,842,782 (MALIK ET AL) is cited to teach a method and apparatus for tracking functional states of a web-site and reporting results to a web developers.

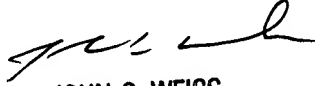
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cang (James) G. Thai whose telephone number is (571) 272-6499. The examiner can normally be reached on 6:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CGT  
5/17/2005

  
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